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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,418	01/05/2001	Jorge M. Ferreira	60001.0009US01	4805

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EXAMINER

PAULA, CESAR B

ART UNIT PAPER NUMBER

2178

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/755,418	FERREIRA ET AL.	
	Examiner	Art Unit	
	CESAR B. PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to the amendment filed on 10/18/2005.

This action is made Final.

2. In the amendment, claims 21-26 have been canceled. Claims 1-3, 5-12, and 14-20 are pending in the case. Claims 1, 11, and 19 are independent claims.

Drawings

3. The drawings filed on 1/5/2001 have been approved by the Examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-3, 5-12, and 14-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 11, and 19 recite “comment appearing at one or more discrete locations within the document”, “comment....visible at a discrete location within the document”, “comment visible within an electronic document” lines 3-4, 2-3, and 3-4 respectively. The Examiner failed to find a description in the specification explaining to one of ordinary skill in the art, how to display the

comment within the document. The comment appears to be overlaid on the document, not included within it (fig.5-6).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-3, 5-12, 14– 20, and 27 remain rejected under 35 U.S.C. 102(a) as being anticipated by Star Office 5.1 Memorandum, and figs (published before 1/5/2001), from IDS submitted on 2/10/2005, hereinafter Staroffice.

Regarding independent claim 1, Staroffice teaches software comment box for deselecting an “Apply user data” checkbox, and clicking Ok for changing—*activating a privacy option comprising computer-implemented instructions*, and replacing or updating personal information, such as an author’s name, from the properties of a file. The comment box is displayed superimposed within the document—including *a comment box appearing at one or more discrete locations within the document*. The author’s name is replaced—*enable removal--* with more generic information, such as date and time of creation/modification—*replacing the one or more pieces of personal information included with each comment with generic information included with each comment appearing in the first document (memorandum, shots 1-2)*.

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Regarding dependent claim 2, Staroffice teaches software for deselecting an “Apply user data” checkbox, and clicking Ok for changing—*saving the first document--*, and replacing or updating personal information, such as an author’s name, from the properties of a file (memorandum, shots 1-2).

Regarding dependent claim 3, Staroffice teaches software for deselecting an “Apply user data” checkbox, and clicking Ok for changing, and replacing or updating personal information, such as an author’s name, from the properties of a file (memorandum, shots 1-2).

Regarding dependent claim 5, Staroffice teaches software for deselecting an “Apply user data” checkbox, and clicking Ok for changing—*saving the first document--*, and replacing or updating personal information, such as an author’s name-- *generic information made up of string of letters--* from the properties of a file (memorandum, shots 1-2).

Regarding dependent claim 6, Staroffice teaches software for deselecting an “Apply user data” checkbox, and clicking Ok for changing and replacing—*removes one or more pieces of personal information from display in the comment appearing within the first document--*, personal information, such as an author’s name, from the properties of a file (memorandum, shots 1-2).

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Regarding dependent claim 7, Staroffice teaches software for deselecting an “Apply user data” checkbox, and clicking Ok for changing—*saving the first document removes one or more pieces of personal information from the first document when the first document is saved--*, and replacing or updating personal information, such as an author’s name, from the properties of a file (memorandum, shots 1-2).

Regarding dependent claim 8, Staroffice teaches replacing or updating personal information, such as an author’s name, in a comment box, from the properties of a file (memorandum, shots 1-2). In other words, the same document—*template--* is used to replace the updated information thereby creating a new or second document containing the updated information.

Claim 9 is directed towards a system for implementing the steps found in claim 1, and therefore is similarly rejected.

Claim 10 is directed towards a computer-readable medium having instructions for executing the steps found in claim 1, and therefore is similarly rejected.

Regarding independent claim 11, Staroffice teaches the default selection of a “Apply user data” checkbox, in a comment box displayed superimposed on a document, enabling the display of an author’s name —*receiving input of one or more pieces of personal information into one or more data storage fields in response to a request for personal information from a*

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document-generating application--. Software dialog comment box is used for deselecting an “Apply user data” checkbox, and clicking Ok for changing—*activate a computer-implemented privacy option*, and replacing or updating personal information, such as an author’s name, from the properties of a file as displayed in the comment box. The author’s name is replaced—*removal--* with more generic information, such as date and time of creation/modification—*replacing the removed personal information with generic information visible within the comment within the document* (memorandum, shots 1-2).

Claims 12, 14-16 are directed towards a method equivalent to the steps found in claims 3, 5, 7, and 1 respectively, and therefore are similarly rejected.

Claim 17 is directed towards a system for implementing the steps found in claim 11, and therefore is similarly rejected.

Claims 18-20 is directed towards a computer-readable medium having instructions for executing the steps found in claims 11, and 1-2 respectively, and therefore are similarly rejected.

Regarding claim 27, which depends on claim 1, Staroffice teaches software for deselecting an “Apply user data” checkbox in a dialog box, and clicking Ok for changing—*activating the privacy option enables removal of personal information from the comment box without removing the comment--* and replacing or updating personal information, such as an author’s name, from the properties of a file, which are displayed in a dialog box—*comment box—along with a document* (memorandum, shots 1-2).

Response to Arguments

8. Applicant's arguments filed on 6/29/2005 have been considered but are not persuasive. The Applicants remark that Staroffice fails to teach or suggest displaying a comment within a document, and appearing at one or more locations (pages 9-10). The Examiner disagrees, because Staroffice teaches that the comment box is displayed superimposed at a location on the document, just as the invention's comment that appears on a separate comment window at a certain area of the document (fig.5-6).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zucker et al. (Pat. # 2005/0027618), Beattie et al (USPat.#. 6,457,002).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The

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examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for **all** Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER
3/22/06